

REMARKS

Applicants thank the Examiner for the indication of allowable subject matter with respect to claim 47. Claim 47 has herein been amended into independent form to include all of the recitations of its base claim and any intervening claims.

The present amendment is fully responsive to the Office Action having a mailing date of January 18, 2008. After entry of this Amendment, claims 28, 30-35, 37-43, 45-56, and 58-68 are pending in the Application. Claims have 28, 30, 33, 37-39, 47, 56, and 58-60 have been herein amended. Claims 29, 36, 44 and 57 have been cancelled without prejudice. New claims 64-68 have been added. No new matter has been added by this Amendment and support for the claims, as amended and added, may be found throughout the specification and drawings. At least for the reasons set forth below, Applicants respectfully traverse the foregoing rejections. Further, Applicants believe that there are also reasons other than those set forth below why the pending claims are patentable, and reserves the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers.¹ Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

Applicants respectfully request reconsideration of the present Application in view of the above amendments, the new claims, and the following remarks.

I. Objections to the Specification

The Examiner has objected to the title of the application as not being descriptive. Applicants respectfully traverse the objection. Nevertheless, Applicants have herein amended the title to read “SELF CENTERING SHIFT LEVER MECHANISM”. Applicants accordingly request that the instant objection be reconsidered and withdrawn.

¹ As Applicants’ remarks with respect to the Examiner’s rejections are sufficient to overcome these rejections, Applicants’ silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such assertions/requirements in the future.

II. Objections to the Drawings

The drawings stand objected to under 37 C.F.R. § 1.83(a). The Examiner contends that certain features recited in claim 44 are not shown in the drawings. The objection, however, is deemed moot in light of the fact claim 44 has been herein cancelled without prejudice. Applicants accordingly request that the instant objection be reconsidered and withdrawn.

III. Objections to the Claims

Claims 56 and 60 have been objected to due to various informalities. Applicants have adopted the Examiner's suggestions in their entirety and have herein amended the claims accordingly. Applicants respectfully request that the instant objections be reconsidered and withdrawn.

IV. Claim Rejections – 35 U.S.C. § 112

Claims 28-63 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The rejection is respectfully traversed.

A. Claims 28, 33 and 56

The Examiner states that it is unclear what is meant by the use of the term "selectively" in claims 28, 33 and 56. Applicants respectfully submit that use of the term does not render the claims unclear. Nevertheless, for purposes of advancing prosecution Applicants have elected to delete the term from the respective claims.

B. Claims 28 and 29 – pivoting means

With regard to claims 28 and 29, the Examiner contends that it is not clear whether "pivoting member" of claim 28 and "pivoting means" of claim 29 are the same or different elements. The rejection is deemed moot given the fact that claim 29 has herein been cancelled without prejudice.

C. Claims 28 and 29 – biasing means

With regard to claims 28 and 29 the Examiner states that it is not clear whether “biasing member” of claim 28 and “biasing means” of claim 29 [sic] (it is presumed the Examiner intended to refer to claim 30, which includes the referenced terms, rather than claim 29) are the same or different elements. Claim 30 has herein been amended to delete the phrase “further comprising a biasing means”.

D. Claims 32, 34, 35, 36, 37, 53 and 57

With regard to claims 32, 34, 35, 36, 37, 53 and 57, the Examiner states that the term “generally” renders the claims indefinite. The rejection is deemed moot with respect to claims 36 and 57, which have herein been cancelled without prejudice. With respect to pending claims 32, 34, 35, 37 and 53, the rejection is respectfully traversed. The term “generally” does not render the claims indefinite. It is widely recognized and accepted practice to use relative terminology, such as “generally”, to account for minor deviations from the claimed subject matter. Minor deviations may occur for a variety of reasons, for example, as a result of manufacturing requirements. Use of the term “generally” to account for minor deviations from the claimed subject matter will not render a claim indefinite provided the term does not negate the meaning of the words it modifies, which in this case it does not. (*See* MPEP 2173.05(b) and USPTO Patent Examination Policy – MPEP Staff – 35 USC 112 Rejections not Based on Prior Art, subheading Claim Interpretation, subparagraph (C)). Accordingly, it is respectfully requested that the instant rejection be reconsidered and withdrawn.

E. Claim 46

With regard to claim 46, the Examiner asserts that use of the phrase “substantially the same” in connection with the second biasing member renders the claim indefinite. The rejection is respectfully traversed. The phrase “substantially the same” does not render the claim indefinite. It is widely recognized and accepted practice to use relative terminology, such as “substantially”, to account for minor deviations from the claimed subject matter. Minor deviations may occur for a variety of reasons, for example, as a result of manufacturing requirements. Use of the term “substantially” to account for minor deviations from the claimed subject matter will not render a

claim indefinite provided the term does not negate the meaning of the words it modifies, which in this case it does not. (*See* MPEP 2173.05(b) and USPTO Patent Examination Policy –MPEP Staff – 35 USC 112 Rejections not Based on Prior Art, subheading Claim Interpretation, subparagraph (C)). Accordingly, it is respectfully requested that the instant rejection be reconsidered and withdrawn.

V. Claim Rejections – 35 U.S.C. § 102

In the Office Action, claims 28-42, 44-45, and 56-62, were rejected under 35 U.S.C. 102(b) as allegedly anticipated by Katayama (US 4,543,842) (hereinafter “Katayama”). The rejection is deemed moot with respect to claims 29, 44 and 57, which have herein been cancelled without prejudice. Applicants respectfully traverse the rejection for at least the following reasons.

A. Independent Claim 28

Claim 28 has been amended to include all of the recitations of dependent claim 36. Claim 36 has accordingly been cancelled without prejudice. Pending claim 28 describes a “third element” that is fixed relative to a “lever”. The Examiner states that pushing member (26) of Katayama corresponds to the “third element” of claim 28 (previously claim 36). However, in contrast to pending claim 28, pushing member (26) of Katayama is not described as being fixed to shift lever (1). Indeed, pushing member (26) does not even contact shift lever (1), let alone being fixed to it. Rather, pushing member (26) contacts spherical member (2), which the Examiner contends is a component of the “pivoting member” of claim 28, and not the shift lever (*see* pg. 8 of the Detailed Action, wherein the Examiner states that the “pivoting member further comprises a spherical element (2, fig 7 [of Katayama])). Furthermore, even if spherical member (2) were to be considered part of shift lever (1), pushing member (26) is also not fixed to spherical member (2), but rather slideably engages the spherical member to enable shift lever (1) and spherical member (2) to be displaced relative to pushing member (26) as the shift lever is actuated. Thus, it cannot be said that pushing member (26) of Katayama is fixed relative to shift lever (1) given the fact that the orientation of the shift lever relative to the pushing member varies continuously as the shift lever is actuated.

Pending claim 28 also includes a “biasing member” disposed intermediate a “second element” and the “third element”. The Examiner states that spacer ring (9) of Katayama

corresponds to the “second element” of claim 28 (previously claim 36), and that spring (19) of Katayama corresponds to the “biasing element”. However, in contrast to claim 28, spring (19) of Katayama is not shown disposed between spacer ring (9) and pushing member (26) (which the Examiner contends corresponds to the “third element” of claim 28). Spring (19) would have to be positioned in the space between the inner diameter of spacer ring (9) and the outer diameter of pushing member (26) in order to be considered disposed between the two components, which it is not. Accordingly, it is submitted that Katayama does not disclose a biasing element disposed between the second and third elements of the biasing member.

B. Dependent Claims 30-35, 37-42, and 45-54

Claims 30-35, 37-42, and 45-54 depend either directly or indirectly from claim 28, and are therefore in a condition for allowance for the same reasons as set forth above with respect to claim 28. Nevertheless, these dependent claims also recite independently patentable subject matter.

For example, claim 33 recites in part that the “biasing member applies a force operable to oppose displacement of said lever in any direction.” In contrast, spring (8) of Katayama, which the Examiner contends corresponds to the “biasing member” of claim 33, only resists movement of shift lever (1) that occurs generally within a plane defined by the longitudinal axis of pin (3) and shift lever (1). Spring (8) does not impede movement of shift lever (1) in any other direction, for example, in a direction perpendicular to the plane defined by shift lever (1) and pin (3) (i.e., when pivoting the shift lever about the longitudinal axis of pin (3)). In order for spring (8) to exert a biasing force against shift lever (1), pin (3) must be tilted in the manner shown in Fig. 7 of Katayama. This causes pin (3) to contact spacer ring (9), displacing it toward spring (8) so as to compress the spring to generate the biasing force (*see* Katayama, column 3, lines 57-68, and column 4, lines 1-16). This does not occur, for example, when shift lever (1) is rotated about the longitudinal axis of pin (3), and as a consequence, spring (8) will not exert a biasing force against shift lever (1). Thus Katayama fails to anticipate the recitations of claim 33, and the Examiner’s rejection of claim 33 should be withdrawn.

Also for example, claim 51 recites in part that the “spherical element is fixed to said lever by a retaining pin.” In contrast, spherical member (2) of Katayama, which the Examiner contends

corresponds to the “spherical element” of claim 51, is not attached to shift lever (1) using pin (10) as the Examiner contends. Pin (10) is used to attach pin (3) to spherical member (2) (*see* Katayama, column 4, lines 30-32). Nowhere does Katayama disclose that pin (10) is used to attach spherical member (2) to shift lever (1). Thus Katayama fails to anticipate the recitations of claim 51, and the Examiner’s rejection of claim 51 should be withdrawn.

Applicants accordingly request that the instant rejections be reconsidered and withdrawn.

C. Independent Claim 56

Claim 56 has been amended to include all of the recitations of dependent claim 57. Claim 57 has accordingly been cancelled without prejudice. Pending claim 57 describes a “third element” that is fixed relative to a “lever”. The Examiner states that pushing member (26) of Katayama corresponds to the “third element” of claim 56 (previously claim 57). However, in contrast to pending claim 56, pushing member (26) of Katayama is not described as being fixed to shift lever (1). Indeed, pushing member (26) does not even contact shift lever (1), let alone being fixed to it. Rather, pushing member (26) contacts spherical member (2) and not the shift lever. Furthermore, even if spherical member (2) were to be considered part of shift lever (1), pushing member (26) is also not fixed to spherical member (2), but rather slideably engages the spherical member to enable shift lever (1) and spherical member (2) to be displaced relative to pushing member (26) as the shift lever is actuated. Thus, it cannot be said that pushing member (26) of Katayama is fixed relative to shift lever (1) given the fact that the orientation of the shift lever relative to the pushing member varies as the shift lever is actuated.

Pending claim 56 also includes a “biasing member” disposed intermediate a “second element” and the “third element”. The Examiner states that spacer ring (9) of Katayama corresponds to the “second element” of claim 56 (previously claim 57), and that spring (19) of Katayama corresponds to the “biasing element”. However, in contrast to claim 56, spring (19) of Katayama is not shown disposed between spacer ring (9) and pushing member (26) (which the Examiner contends corresponds to the “third element” of claim 56). Spring (19) would have to be positioned in the space between the inner diameter of spacer ring (9) and the outer diameter of

pushing member (26) in order to be considered disposed between the two components. Accordingly, it is submitted that Katayama does not disclose a biasing element disposed between the second and third elements of the biasing member.

Applicants accordingly request that the instant rejections be reconsidered and withdrawn.

D. Dependent Claims 58-62

Claims 58-62 depend either directly or indirectly from claim 56, and are therefore in a condition for allowance for all the same reasons as set forth above with respect to claim 56. Applicants accordingly request that the instant rejections be reconsidered and withdrawn.

VI. Claim Rejections – 35 U.S.C. § 103

In the Office Action, dependent claims 43, 55 and 63 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Katayama, as applied to claim 39, and further in view of Kessmar (US 4,104,929) (hereinafter “Kessmar”). Applicants respectfully traverse the rejection. The cited references, whether taken singularly or in any permissible combination, do not anticipate, teach, or suggest the subject matter of pending claims 43, 55 and 63. As discussed above with respect to independent claims 28 and 56, from which claims 43, 55 and 63 depend either directly or indirectly, Katayama does not disclose a “third element” fixed relative to a “lever”. Katayama also does not disclose a “biasing member” disposed intermediate a “second element” and a “third element”. These deficiencies are not overcome by the addition of Kessmar. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

In the Office Action, dependent claims 43, 55 and 63 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Katayama, as applied to claim 28 and 56, respectively, and further in view of Kessmar. Applicants respectfully traverse the rejection. The cited references, whether taken singularly or in any permissible combination, do not anticipate, teach, or suggest the subject matter of pending claims 43, 55 and 63. As discussed above with respect to independent claims 28 and 56, from which claims 43, 55 and 63 depend either directly or indirectly, Katayama does not disclose a “third element” fixed relative to a “lever”. Katayama also does not disclose a “biasing member” disposed intermediate a “second element” and a “third element”. These

deficiencies are not overcome by the addition of Kessmar. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

VII. Allowable Subject Matter

Claim 47 is indicated as being allowable if rewritten to include all of the recitations of the base claim and any intervening claims. Claim 47 has been herein amended to include all of the recitations of base claim 28 and intervening claim 45. The amendments to claim 47 also address the issues raised by the Examiner in connection with the rejections under 35 U.S.C. § 112, second paragraph. Thus, it is submitted that claim 47 is in a condition for allowance.

VIII. Provisional Double Patenting Rejection

Claim 28 stands provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 41 of co-pending Application No. 10/519,026. The provisional rejection is deemed moot in light of the amendments to claim 28. Applicants accordingly request that the provisional rejection be reconsidered and withdrawn.

IX. New Claims

New claims 64-67 have been added in this amendment for the Examiner's consideration. The cited references, whether taken singularly or in any permissible combination, do not anticipate, teach or suggest the subject matter recited in new claims 64-67. In contrast to new claims 64-67, spacer ring (9) of Katayama, which the Examiner states corresponds to the "second element" of the pending claims, is not shown to slideably engage shift lever (1). Katayama also does not describe the spacer ring (9) as moving axially along the longitudinal length of shift lever (1) as the lever is displaced from its biased position. Furthermore, spring holder (21) of Katayama, which the Examiner states corresponds to the "first element" of the pending claims, is not shown to contact spacer ring (9). Also, pushing member (26) of Katayama, which the Examiner states corresponds to the "third element" of the pending claims, is not described as contacting spacer ring (9). In addition, the biasing force applied by spring (19) of Katayama, which the Examiner states corresponds to the "biasing element" of the pending claims, does not urge spacer ring (9) into

contract with pushing member (26). These deficiencies are not overcome by the addition of Kessmar. Thus, the Examiner's consideration of new claims 64-67 is accordingly requested.

CONCLUSION

Reconsideration and allowance are respectfully requested. In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

It is believed no fees are due with this response. However, if any fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge our Deposit Account No. 18-0013, under Order No. 65856-0068 from which the undersigned is authorized to draw. Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 65856-0068 from which the undersigned is authorized to draw.

Dated: April 18, 2008

Respectfully submitted,

Electronic signature: /Daniel J. Checkowsky/
Michael B. Stewart

Registration No.: 36,018

Daniel J. Checkowsky

Registration No.: 51,549

RADER, FISHMAN & GRAUER PLLC

Correspondence Customer Number: 10291

Attorneys for Applicants